

REMARKS

Claims 1-12 and 23-28 are pending. Claims 1-12, 23, and 27 stand rejected under the judicially created doctrine of obviousness-type double patenting over U.S. Patent No. 5,870,723 to Pare, Jr. et al. in view of U.S. Patent No. 6,269,348 to Pare, Jr. et al. Claims 1-12 and 23-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,070,141 to Houvener et al. in view of U.S. Patent No. 5,291,560 to Daugman.

Reconsideration is requested. No new matter is added. Terminal disclaimers will be filed to overcome the obviousness-type double patenting rejections of claims 1-12, 23, and 27 once the claims are allowed over the prior art. Claim 3-5, 10, and 23 are amended. Claims 29-31 are added. The rejections are traversed. Claims 1-12 and 23-31 remain in the case for consideration.

REJECTION OF CLAIMS 1-12, 23, AND 27 AS BEING OBVIOUSNESS-TYPE DOUBLE PATENTED OVER U.S. PATENT NO. 5,870,723

As indicated in the Response to the Office Action dated October 23, 2002, a terminal disclaimer will be filed once the claims are allowed over the prior art.

REJECTION UNDER 35 U.S.C. § 103(a)

Referring to claim 1, and more specifically to the transmission and user identification steps, the claim recites forwarding a user's bid biometric sample to a computer system and comparing a bid biometric sample with registration biometric samples for identification of the user. Claim 1 describes a single step process for identifying a user. A user presents a bid biometric sample and the user is identified in a single step. Thus, there is no need for a second, identification-verifying step. Also, claim 1 recites the use of the user's bid biometric sample to identify that user without requiring any other information such as account number, driver's license number, social security number or the like.

In contrast, Houvener is directed toward identity verification and more particularly to a "a system and method of assessing the quality of an identification transaction." Houvener discloses throughout the specification a two-step process for verifying the identity of a user attempting to perform a transaction. Even the claims of Houvener, including claim 21, describe a two-step process for verifying the identity of a user.

With respect to the two-step process, the Summary of the Invention, at column 3, lines 14-61, is exemplary of the whole Houvener disclosure. This section discloses that the user "will present a first identification unit" to initiate a transaction. Then in a second step

after retrieving a second identification unit corresponding to the first identification unit, the user's identity is compared to this second identification unit either by a responsible person or an automatic comparison system. Thus, Houvener lacks any description and enablement of utilizing a single step for identifying a user for authorization of a transaction.

Daugman discloses a system for identifying a person based on the iris of either eye. Daugman does not teach the missing element of a using a single step (and not two steps) to identify a user for authorization of a transaction.

A basic advantage of the present invention is the very fact that only a single step is required to identify the user. The invention meets the needs stated on page 4 of the present specification in supplying an account access system that ensures customer convenience by not requiring the customer to possess, carry, and present a man-made memory device and by eliminating the need to memorize PIN codes. By requiring two steps in the process, Houvener necessarily requires either the possessing and presenting of some man-made memory device or requiring the user to memorize an account number or PIN code. Importantly, Daugman does not provide any motivation for Houvener to change the two-step process into a single-step process.

It is important to note that Daugman pre-dates Houvener. Daugman issued on March 1, 1994, more than four years prior to the filing of Houvener. Houvener specifically points to the possible use of a retinal image comparison system at column 3, lines 48-49. However, Houvener chose to disclose and claim a two-step process that throughout the specification calls for first identifying the user by an account number and not a biometric sample. The biometric sample in Houvener, as stated by the Examiner on page 6 in paragraph 4 of the Response dated January 23, 2004, is used to *verify* that identification.

The only place in Houvener to which the Examiner can cite that might possibly show that a biometric sample could be used in the first of the two steps is within claim 21. The examiner cites that this claim implies that the first identification unit used in the first step in claim 20 could be a biometric identifier and not an account number. However, Houvener completely fails to enable any kind of system or process that would use the biometric identifier in the first step. Throughout the specification, Houvener only describes using an account number first to identify a user in a first step. One obvious way of identifying a user from an account number would be to simply look up the account number on a list of account numbers and a user's name would be associated with that account number. Houvener fails to enable or describe any way to compare a user's biometric analog information to a plurality of user registration biometric samples (this biometric data comparison would not be a simple

table look up). And even if Daugman could be combined with Houvener to show how a biometric sample could be compared with registration samples, Daugman fails to teach the concept of a single-step process.

Aside from the fact that the Examiner's interpretation of claim 21 as teaching using the biometric as the first identification unit in Houvener is not enabled by the Houvener specification, such an interpretation of claim 21 leads to the illogical conclusion that the identification number can be used to verify the user's identity. As previously argued, an arbitrarily assigned number (be it from a governmental agency or some private organization) provides no identifying value: anyone could have the number, and the mere fact that the user presents a number to the clerk does not support the user's position that he is who he says he is.

Thus, the two-step process disclosed in Houvener in view of iris identification in Daugman does not result in the single step process of the present invention. Therefore, independent claim 1 is patentable over Houvener in view of Daugman and claim should be allowed.

To help emphasize the one-step nature of the identification in the claims, new claim 29 describes the user identification as being performed using only the bid biometric sample. Claim 30 embellishes this point, claiming that the user identification is completed without any transmission of information from the computer system to the user or the seller. In other words, claims 29 and 30 emphasize that user identification is accomplished without using a second identification unit, as required by Houvener, which requires transmission of the second identification unit back to the point of identification (*see, e.g.*, column 3, lines 39-41). That the user's selection of a financial account is merely the identification of an account associated with the user, and not part of the *user* identification, is emphasized in claim 31.

In addition, the dependent claims are also allowable over Houvener in view of Daugman for other reasons. For example, claim 10 is directed toward the user entering an amount for the transaction that includes a cash back value. The Examiner argues that it is well known to receive cash back in transactions. The Examiner is arguing in hindsight. It may be well known today to receive cash back in transactions; but to establish obviousness over common knowledge the Examiner must show that the common knowledge existed at the time of the invention. This application was filed in December 1998; accordingly the Examiner must show that it was common knowledge in 1998 to receive cash back. The Examiner has not met this burden, and so has failed to establish a *prima facie* argument that claim 10 is obvious over Houvener in view of Daugman.



With reference to claim 11, the claim is directed toward comparing registration biometric samples with previously registered biometric samples to recognize that a user has re-registered. The Examiner argued that Houvener discloses this concept, and refers to column 6, lines 52-67, and column 7, lines 38-42. The Examiner is arguing from general comments made in Houvener, without addressing the specifics of the claim. Column 6, lines 52-67 discusses the problem of identity-based fraud with reference to identification documents that are susceptible to forgery. Column 7, lines 38-42 discusses other identity-based fraud indicators, and specifically mentions the possibility of "an individual enrolling an abnormally large number of accounts . . . in a short period of time or . . . under different names using a common address." While this excerpt describes one technique to recognize a user registering multiple times with the system, it is by no means the only way to recognize such an occurrence. And to take a general comment about fraud, interpret it to mean that there is a need to watch for re-registration in all circumstances, and use that interpretation to reject any and all other techniques to identify re-registration misinterprets the language of Houvener. In addition, Houvener does not teach or suggest that *any* re-registration be recognized; the quoted excerpt describes a situation where a particular form of re-registration might be suspect.

For the foregoing reasons, reconsideration and allowance of claims 1-12 and 23-31 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

RECEIVED
APR 30 2004
GROUP 3600

MARGER JOHNSON & McCOLLOM, P.C.
1030 SW Morrison Street
Portland, OR 97205
503-222-3613
Customer No. 20575

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

Ariel S. Rogson
Ariel S. Rogson
Reg. No. 43,054

HEREBY CERTIFY THAT
THIS CORRESPONDENCE IS
BEING DEPOSITED WITH THE
UNITED STATES POSTAL
SERVICE AS FIRST CLASS
MAIL IN AN ENVELOPE
ADDRESSED TO:

☐ COMMISSIONER OF PATENTS
AND TRADEMARKS WASHINGTON
D.C. 20231

☒ MAIL STOP **AF**
COMMISSIONER FOR PATENTS
BOX 1450
ALEXANDRIA, VA 22313-1450

☐ BOX
COMMISSIONER
FOR TRADEMARKS 2800 CRYSTAL
DRIVE ARLINGTON, VA 22202-3513

ON **APR 26 2004**
Ariel S. Rogson